

REMARKS

This responds to the Office Action mailed on December 10, 2003.

Claims 25-30 are now pending in this application. No new matter is believed to be introduced by such amendments.

§112 Rejection of the Claims and claim objections

Claim 30 was rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicants cannot find the exact phrase referenced as problematic by the Examiner. The software key first appears in “a storage device coupled to the processor and storing a GPS unit unique software key;” This phrase refers to there being a software key that is unique for the GPS unit. Every other reference to the software key in claim 30 correctly references such key by referring to “the unique software key”. Thus, there is no second unique software key, and the language is believed clear.

§103 Rejection of the Claims

Claims 25-30 were rejected under 35 USC § 103(a) as being unpatentable over Behr et al. (U.S. Patent No. 6,107,944) in view of Hornbuckle (WO 90/13865) and Ahrens et al. (U.S. Patent No. 5,951,620). The rejection is respectfully traversed for the reasons stated in the previous response, which are incorporated herein, in addition to the further following remarks.

Behr et al. describes a memory constrained system remote or mobile unit that does not contain detailed maps. It addresses the problem of providing more detail from a base station for a single route. Since the single route is of interest only to one user, it has no value to other users, and there is no need for encryption as provided for in all of the currently pending claims. All of the discussion in Behr et al. of downloading up-to-date information is in the context of allowing a “mobile unit to operate with limited or no database storage...” Col. 22, lines 23-24. Further, information is downloaded to the mobile unit “for those portions of the route which are not adequately covered by maps available on-board the remote unit.” Col. 21, line 67 to Col. 22, line 2.

The Office Action indicates that Hornbuckle provides motivation for securing transmitted software, citing “Behr et al’s desire for sending software only to paying customers were accomplished without pirating/hacking by unauthorized, non-paying customers.” No such desire is gleaned from Behr et al. As indicated above, Behr et al. transmits information related to selected routes, which is of interest only to the person seeking to follow the route. There is no need for encryption, and hence no motivation to combine Behr et al. with Hornbuckle, and the rejection should be withdrawn.

Ahrens et al. is cited as providing hardware identification. It is not cited as providing a motivation to combine Behr et al. and Hornbuckle. It further teaches away from wireless distribution, and requires directly connecting hardware at a physical kiosk to accomplish software updates. A *prima facie* case of obviousness has not been established, and the rejection should be withdrawn.

The combination of the references also does not disclose the inclusion of payment authorization information in a request as claimed in the independent claims. The phrase “payment authorization information” goes beyond “billing and audit information.” The latter describes where to send a bill. Payment of the bill is an entirely separate act. The bill can still be disputed and not paid. Payment authorization information is defined in the application as an actual method of payment, such as credit card information or means of electronic payment as indicated on page 8, lines 3-10. It is not merely billing and audit information as described in Behr et al. at col. 14, line 3. The Office Action indicates that the request for updated navigation information in Behr et al. inherently includes payment authorization information. Applicant respectfully disagrees because the Office Action has not established a *prima facie* case of inherency.

As recited in MPEP § 2112, “In relying upon the theory of inherency, the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,” citing Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Office Action appears to indicate that billing and audit information as well as information identifying the subscriber inherently includes payment authorization. Thus, the Office Action does not even assert that the allegedly inherent characteristic is necessary, let

alone provide a basis in fact and/or technical reasoning. Applicant respectfully submits that payment authorization does not necessarily flow from billing information, because billing information may only indicate where to send a bill. It does not inherently authorize payment. Since payment authorization does not necessarily flow from billing information, it is not an inherent characteristic, and the rejection should be withdrawn.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6972 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

KELLY E. DILLARD ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6972

Date 2-10-2004

By 
Bradley A. Forrest
Reg. No. 30,837

G
CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 10 day of February, 2004.

Name

GINA J. Phelps

Signature

GINA J. Phelps